



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,290	06/21/2000	Tamotsu Miyagawa	040894-5551	7547

9629 7590 01/27/2005

MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER

ONUAKU, CHRISTOPHER O

ART UNIT	PAPER NUMBER
----------	--------------

2616

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/598,290

Applicant(s)

MIYAGAWA, TAMOTSU

Examiner

Christopher O. Onuaku

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,4&8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Mimura et al (US 5,963,704).

Regarding claim 1, Mimura et al disclose a recording medium such as an optical disk for recording data corresponding to different objects, different types of compressed dynamic images and voice data, including an apparatus for recording/reproducing data to and from the recording medium, a method for reproducing the data from the recording, comprising:

Art Unit: 2616

a) a memory (see Fig.1 and disk 10; col.8, line 63 to col.9, line 24) for storing a plurality of setting parameters respectively associated with predetermined kinds of data contents (see col.16, lines 40-67; col.17, lines 4-17; col.22, line 51 to col.23, line 10; and col.23, lines 15-28), wherein the parameters include end address of the video manager menu language units, number of pieces of the VMGM program chain information, end address of the video title set menu language units, start address of the associated video title set menu language unit;

b) a discriminator (identifier) for discriminating the data contents stored in the recording medium (see cell identifier, VOB identifier, video title set identifier; col.13, lines 29-38; col.18 lines 23-35, and col.22, lines 18-30);

c) a parameter selector for selecting at least one of the setting parameters stored in the memory and associated with the discriminated data contents (see CPU section 50; col.36, lines 40-52; col.37, lines 6-17);

d) a content selector for selecting at least one of the data contents stored in the recording medium based on the selected setting parameter contents (see CPU section 50; col.36, lines 40-52; col.37, lines 6-17); and

e) a plurality of selectable data contents which are related to an identical reproduction time of the reproduced content (see col.13, line 57 to col.14, line 5 for playtime of VOB and col.20, lines 38-55 for playtime of a PGC).

Regarding claim 2, Mimura et al disclose wherein the discriminator discriminates the data contents in the recording medium based on discrimination information recorded on the recording medium (see col.43, line 60 to col.44, line 13).

Regarding claim 4, Mimura et al disclose wherein the discriminator discriminates the data contents stored in the recording medium by analyzing setting data recorded in the recording medium (see col.43, line 60 to col.44, line 13).

Regarding claim 8, Mimura et al disclose wherein the parameter selector automatically selects a predetermined setting parameter when no parameter setting associated with the discriminated data contents is stored in the memory (see col.50, lines 1-17).

Regarding claim 9, the claimed limitations of claim 9 are accommodated in the discussions of claim 1 above, including the claimed reproducing function.

Regarding claim 10, the claimed limitations of claim 10 are accommodated in the discussions of claim 8 above.

Regarding claims 11&12, Mimura et al disclose wherein the plurality of setting parameters are associated with at least two of voice, subtitle, dubbed audio, PCM data, and MPEG video (see col.37, lines 57-65; col.38, lines 14-20; and col.33, lines 15-34).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2616

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3,5,6&7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mimura et al in view of Kikuchi et al (US 6,577,812).

Regarding claim 3, Mimura et al fail to explicitly disclose wherein the discriminator information is the BCA data. Kikuchi et al teaches a digital information recording/playback system using a digital information recording medium having a limited storage amount, comprising a 2048 byte physical format information, wherein the sixth byte position "16" describes a burst cutting area (BCA) descriptor, the BCA is applied as an option to a DVD-ROM disc alone, and is an area for storing recorded information upon completion of the disc manufacturing process. (see Fig.6, col.12, lines 57-61). It would have been obvious to modify Mimura et al by realizing Mimura et al with BCA data, as taught by Kikuchi, since the BCA is applied as an option to a DVD-ROM disc alone, and is an area for storing recorded information upon completion of the disc manufacturing process.

Regarding claim 5, Kikuchi teaches wherein the setting data is data indicating a total reproduction time of stored data (see col.25, lines 35-43).

Regarding claim 6, Kikuchi teaches wherein the setting data is data indicating a total number of chapter of stored data (see col.63, lines 20-29).

Art Unit: 2616


Regarding claim 7, Kikuchi teaches wherein the data contents stored in the recording medium include plural kinds of dubbed audio data and subtitles (sub-picture) of the reproduced content (see Fig.9; col.17, line 60 to col.18, line 10), and wherein the content selector includes an audio decoder for decoding one of the dubbed audio data and a sub-picture decoder for decoding one of the subtitles data in accordance with the selected setting parameter, respectively (see Fig.26; col.29, lines 44-64).


### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher O. Onuaku whose telephone number is (703) 308-7555. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
COO  
1/21/05

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600